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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,241	07/15/2003	Stephen N. Donnigan	DynDecoy-US Nonprov	1282
33549	7590	11/02/2005	EXAMINER	
SANTANGELO LAW OFFICES, P.C.			ROWAN, KURT C	
125 SOUTH HOWES, THIRD FLOOR			ART UNIT	
FORT COLLINS, CO 80521			PAPER NUMBER	

3643

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,241

Applicant(s)

DONNIGAN ET AL.

Examiner

Kurt Rowan

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 9, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-38, 40-49, 51-61, 63-94, 96-101, 103-112, 114-121, 123-142, 145-149 is/are pending in the application.
- 4a) Of the above claim(s) 6-30, 48-49, 64-88, 109-112, 117, 124-126, 138-139, is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected. 1, 3-5, 31-38, 40-45, 51-61, 63, 89-94, 96-101, 103-108, 114-116
- 7) ☐ Claim(s) _____ is/are objected to. 118-121, 123, 127-137, 140-142, 145-149
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 5 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 96 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 96 depends on canceled claim 95.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 31-38, 40-45, 50-61, 63, 89-94, 96-101, 103-108, 114-116, 118-121, 123, 127-137, 140-142, and 145-149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babbitt et al. (U.S. 6,212,816) for substantially the same reasons stated in the first Office Action.
3. The patent to Babbitt shows a decoy 10 having a base element 36, a turntable 45 responsive to the base element, an electrical wind independent turntable motion provision element 16, 17, 18, 19 as shown in Fig. 11 , and a game bird decoy attachment 26. Babbitt does not disclose that the game bird decoy moving apparatus is usable to move each of at least three different type of separately commercially

Art Unit: 3643

available game bird decoys without requiring substantive modifications. In reference to claims 1, 52, 116, 129, 146, and 148, it would have been obvious to employ at least three different commercial decoys to suit different hunting conditions such as for different game birds and different poses of these birds such as feeding, resting, or sentry. Babbitt discloses incorporating the invention to shell decoys such as shown in Fig. 8. Note that there is no disclosed modification of the shell decoy shown. Clearly there are more than three different types of shell decoys available and that the separately commercially available game bird decoys would be sold in market condition and no adaptation is required that is specifically intended to facilitate the use of the separately commercially available game bird decoy. In reference to claim 148, Babbitt discloses removing the legs and feet portion of a full body decoy in column 5, lines 60-65 to provide a flat bottom surface for the plug-in apparatus. However, the feet of a full body decoy of the prior art would also provide a flat bottom surface for the plug-in apparatus and hence, Babbitt would be usable with a full body decoy having a foot assembly without requiring the removal of the foot assembly of the free standing full body decoy. In reference to claim 3, Babbitt shows an electric motor 16. In reference to claim 4, Babbitt shows a substantially disc shaped turntable 45 in Fig. 4. In reference to claim 5, Babbitt shows a goose decoy. In reference to claim 31, Babbitt does not disclose if the decoy is sold separately, but Babbitt clearly contemplates using different decoys as disclosed in column 5, lines 18-22 and possibly could be employing commercially available decoys since it is disclosed to cut off the legs and feet of a full body decoy in column 5, lines 60-67. Babbitt also discloses that it is a prior art decoy

that is modified. At any rate, it would have been obvious to employ commercially available decoys since the function is the same and the user could thus avoid the pitfalls of having to make their own decoys such as time and expense. In reference to claim 32, Babbitt does not disclose that the sweep rotates faster in one direction than the other, but it would have been obvious to make the sweep rotate faster in one direction to make the decoy more life-like. In reference to claim 33, Babbitt shows a camming device 19, 20 to which the turntable is response. In reference to claim 34, Babbitt discloses a 30 degree sweep in column 4, line 33. In reference to claim 38, Babbitt discloses a full body decoy. In reference to claim 39, Babbitt does not disclose the recited commercial decoys, but it would have been obvious to employ any of the recited decoys to attract game birds while hunting, noting that the function of all the recited game bird decoys is the same. In reference to claim 40, Babbitt shows a column 11 having a base (not labeled but located directly under the turntable 45 in Fig. 2) on a lower portion of the turntable 45. In reference to claim 41, Babbitt shows an electric motor 16 in column 11 as shown in Fig. 2. In reference to claim 42, Babbitt shows the column comprises at least a part of the game bird attachment means 26 since the attachments means is located on the turntable which is located on the column. In reference to claim 44, Babbitt shows a circular column 11, but it would have been obvious to employ a non-circular cross-section since changes in shape are obvious noting that the function is the same. See *In re Dailey et al.*, 149 USPQ 47. In reference to claim 45, Babbitt shows a battery pack or power supply 14 in column 4, lines 46-47. In reference to claim 51, Babbitt discloses that the game bird decoy

employed is from the prior art, and that, it is full body decoy. However, it would have been obvious to employ other decoy shapes such as shell decoys depending on hunting conditions and the type of game bird being sought.

Response to Arguments

4. Applicant's arguments filed August 9, 2005 have been fully considered but they are not persuasive. Applicant's response overcomes the objections to the drawings and the rejection under 35 USC 112, second paragraph. In response to applicant's argument that there is no suggestion to modify the reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion or motivation is generally available to one of ordinary skill in the art. Second, there is a reasonable expectation of success since Babbitt shows full body decoys and shell decoys (Figure 8) used with the apparatus. Third, the prior art reference teaches or suggest all of the claim limitations noting that the game bird decoy moving apparatus of Babbitt is capable of being used to move each of at least three different types of separately commercially available game bird decoys at different times without requiring substantive modifications of any of each of the at least three different types of the separately commercially available game bird decoys that are sold in market condition noting the shell decoy 23 disclosed by Babbitt

Art Unit: 3643

and this decoy is sold in market condition that does not reflect any adaptation that is specifically intended to facilitate use of the separately commercially available game bird decoy. Hence Babbitt does not require modification of the shell decoy or the silhouette decoy 42 as shown in Fig. 9. The response states that in column 6, lines 30-50 of Babbitt refer to adoptions that must be made to an as-purchased decoy so that they can be used with the apparatus. However, no modifications are required to the shell decoy or the silhouette decoy as opposed to the full body decoy as described in column 5, lines 60-65. As Babbitt states in the Abstract, that a full body, shell or silhouette bird decoys of the prior art can be adapted or modified to include the oscillating mechanism, it should be noted that what has to be done depends on what kind of decoy is being employed. The present invention uses decoys that are adapted to be used with a moving apparatus. Thus the claimed invention does not differentiate over Babbitt. Also, there is motivation to modify the reference to Babbitt which is to suit changing or different hunting conditions which Babbitt recognizes since several types of decoys are employed with his apparatus and there is a reasonable expectation of success since Babbitt employs several different types of decoys with his apparatus. Applicant has submitted no evidence that Babbitt would not function in the manner intended to generate the claimed subject matter.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/621,241
Art Unit: 3643

Page 8

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a long, sweeping checkmark-like stroke extending from the end of the name.

Kurt Rowan
Primary Examiner
Art Unit 3643

KR